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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,450	11/25/2003	John J. Breen	16356.827 (DC-05388)	7118

27683 7590 11/29/2006

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EXAMINER

ONEILL, KARIE AMBER

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,450

Applicant(s)

BREEN ET AL.

Examiner

Karie O'Neill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 29-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Amendments filed by Applicant on September 12, 2006, have been received. Claims 1, 4, 9, 11, 12, 15, 20, 22, 29, and 38 have been amended. Claims 29-38 have been withdrawn from consideration based upon amendments which have changed the subject matter of the original claims.

Election/Restrictions

2. Claim 29 has been amended to be directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The subject matter of the aforementioned claim is a "method of manufacturing and shipping" as classified in Class 705, which is distinct from the "information handling system (IHS)" as recited in the original claim.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claim 38 has been amended to be directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The subject matter of the aforementioned claim is a "method of manufacturing and shipping" as classified in Class 705, which is distinct from the "battery powered device" as recited in the original claim.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 38 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. With regard to Claim 12, the informality of using an acronym for the first time without spelling out the full name from which the acronym derived has been corrected. Therefore, the objection has been withdrawn.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the independent claims are found to be confusing because the subject matter of the claim limitations is directed to a “method of manufacturing a battery powered device” and “method of manufacturing a battery for use in a battery powered device”, but the bulk of the limitations are directed to the method of transporting the subassemblies.

7. Claims 1 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner what a “regulatory

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threshold is considered to be, what "a manner satisfying" a regulatory threshold entails and what is considered "sufficient" in terms of the aforementioned regulatory threshold.

8. Claims 1 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner what is meant by "increased shipping costs". What are these costs compared to so one would know what an increase in cost may be?

9. Claims 1 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner what comprises a "chemical element". Does "chemical element" mean just the active material of the battery, the electrolyte, or the active material and electrolyte combined?

10. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner in the term "after shipping" when "after" is. Is "after" when it arrives at the battery manufacturing facility or when the consumer takes it home? At what point is "after"?

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-3, 9-13, 15-17, 19-21 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kouzu et al. (US 6,211,645 B1) in view of Rasmussen et al. (US 2003/0167244 A1).

With regard to Claims 1-3, 11, 15-16, and 20, Kouzu et al. disclose a battery power source device wherein battery modules consisting of a plurality of single cells, which can be considered subassemblies, are connected to one another both electrically and mechanically in series, bus bars being provided that supply electrical connection between the terminals of the battery modules so that the electrical capacity of both battery subassemblies connected together is more than the electrical capacity of just one battery subassembly (column 2 lines 28-36). Kouzu et al. disclose the battery power source connected to and being used as a motor drive source or the like to power electrically powered automobiles (column 1 lines 12-13).

Kouzu et al. do not disclose the first and second subassemblies being packaged separately during shipping in a manner satisfying a regulatory threshold so as to avoid increased shipping costs when the subassemblies are shipped already connected, the regulatory threshold including a battery characteristic such as one of a watt hour rating of the battery and a weight of a chemical element of the battery, and connecting the battery subassemblies after shipping.

Rasmussen et al. disclose a method of optimizing weight based delivery fees. The contents of the components to be shipped may be modified to reduce the overall weight of the package to be shipped when such a weight reduction results in the

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package weight being within a lower weight category resulting in a lower delivery cost (paragraph 0010). While Rasmussen et al. do not disclose the components to be shipped as battery subassemblies, it is disclosed that once the individual weights of the components of the parcel have been determined, a total weight of the parcel is calculated and a comparison between the total weight and the incremental weight breakpoints is made. If the delivery fee of the individual components is less than that of the total weight of the components it would be evident that one would ship the individual components separately. Therefore, it would have been obvious to one of ordinary skill in the art to ship each of the batteries separately so as not to damage the cells in transit, and in order to keep the shipping costs down so as to maintain a product that is cost effective and within a price range for the consumer to purchase both of the battery subassemblies. Consequently, they are to be used together to power the battery powered device, as disclosed by Kouzu et al..

With regard to Claims 9-10 and 27-28, Kouzu et al. disclose battery modules consisting of a plurality of single cells, or battery subassemblies, connected electrically and mechanically in series, are arranged parallel to each other and held in a hold casing, bus bars being provided that supply electrical connection between the terminals of the battery modules (column 2 lines 28-36). It is known in the art that it is common practice to connect battery subassemblies in series to increase voltage and to connect the battery subassemblies in series to increase voltage.

With regard to Claims 12 and 13, Kouzu et al. do not specifically disclose that the battery subassemblies would be connected to the battery device either by the customer

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upon set-up of the system or by the company that manufactures the battery powered device before purchase. However, it is the position of the examiner that it would have been obvious at the time of the invention to do so, given that Kouzu et al. and the instant application utilize two battery subassemblies that would need to be connected at some point in the assembly process before being able to supply power and be used with any battery powered device.

With regard to Claim 17, Kouzu et al. disclose, the single cells, made of nickel-hydrogen secondary cells arranged, disposed in a holder casing horizontally in matrix fashion on respective vertical and transverse straight lines (column 2 lines 49-55).

With regard to Claims 19 and 21, Rasmussen et al. disclose the shipping system designed to identify attributes of individual components (paragraph 0018 and claim 4), attributes which could include the energy capacity of battery components among other features. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to use the attributes of the battery assembly of Kouzu et al. to determine the shipping costs of the battery assembly, because Rasmussen et al. teach optimizing the weight based delivery fees to be lower than a delivery fee based upon the total weight of the components being shipped.

13. Claims 4-8, 18 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kouzu et al. (US 6,211,645 B1) and Rasmussen et al. (US 2003/0167244 A1), as applied to Claims 1-3, 9-13, 15-17, 19-21 and 27-28 above, and in further view of Osaka (US 5,628,054).

Kouzu et al. and Rasmussen et al. disclose the method of manufacturing a battery for a battery powered device in paragraph 12 above, but do not disclose the first battery subassembly exhibiting a first cell chemistry, the second battery subassembly exhibiting second cell chemistry, the first cell chemistry being different from the second cell chemistry, the first cell chemistry having a lithium ion chemistry and the second cell chemistry having a nickel metal hydride chemistry.

With regard to Claims 4-8 and 22-26, Osaka discloses in Figure 1, a battery pack (14) containing two battery subassemblies with different cell chemistry; a nickel metal hydride battery (14a) and a lithium ion battery (14b). Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to use two battery subassemblies with different cell chemistry in the battery assembly of Kouzu et al., because Osaka teach being able to supply more voltage to a battery powered device through the low internal resistance and high output voltage of the nickel metal hydride battery and the low voltage lithium ion battery.

With regard to Claim 18, Osaka discloses the battery pack being provided with power output terminals (15a, 15b) for connection to the nickel metal hydride battery (14a) and the lithium ion battery (14b) for connecting to the power input terminals (16a, 16b) of the main unit (12) (column 3 lines 21-55). Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to electrically connect the battery pack of Kouzu et al. to electrical connectors of the battery powered device, because Osaka teaches supplying power to a device so it is able to function.

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14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kouzu et al. (US 6,211,645 B1) in view of Rasmussen et al. (US 2003/0167244 A1), as applied to Claims 1-3, 9-13, 15-17, 19-21 and 27-28 above, and in further view of Townsley et al. (US 5,532,524).

Kouzu et al. and Rasmussen et al. disclose the method of manufacturing a battery for a battery powered device in paragraph 12 above, but do not disclose the battery powered device being an information handling system.

Townsley et al. discloses an information handling system as a computer system (20), having a central processing unit, memory, as well as a microcontroller unit to control power allocation through certain power lines throughout the computer system (column 5 lines 36-39). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to use an information handling system as the battery powered device in the method of Kouzu et al., Rasmussen et al. and Osaka, because Townsley et al. teach battery packs supplying power to the information handling system.

Response to Arguments

15. Applicant's arguments, see pages 9-11, filed September 12, 2006, with respect to the rejection(s) of claim(s) 1-38 under 35 U.S.C. 103(a) have been fully considered and are not persuasive. However, upon further consideration, a new ground(s) of rejection is made in view of Rasmussen et al. (US 2003/0167244 A1).

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karie O'Neill whose telephone number is (571) 272-8614. The examiner can normally be reached on Monday through Friday from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karie O'Neill
Examiner
Art Unit 1745

KAO



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PRIMARY EXAMINER